

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HILL DESIGN, INC., Opposer, v. ROYLCO, INC. Applicant.	Applicant: Roylco, Inc. Marks: BROWN BAG CRAFTS BROWN BAG CRAFTS and DESIGN Opposition No: 91158755 Serial Nos: 76/299,860 and 76/299,861 Atty. Docket No: 029102.00006
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**APPLICANT'S MOTION TO SUSPEND OPPOSITION PROCEEDINGS
PENDING THE OUTCOME OF CIVIL LITIGATION
CASE NO: 8:04-CV-1397-27 PENDING IN THE
UNITED STATES DISTRICT COURT
DISTRICT OF SOUTH CAROLINA**

Applicant Roylco, Inc., by and through its undersigned attorneys, respectfully requests that the Trademark Trial and Appeal Board suspend these opposition proceedings pending the resolution and final determination of the civil action currently pending in the United States District Court for the District of South Carolina, Civil Action No: 8:04-CV-1397-27 (the "South Carolina action").¹ See T.T.A.B. § 510.02(a).

In this opposition, Opposer seeks the cancellation of Applicant's trademark applications serial nos. 76/299,860 and 76/299,861. On July 6, 2004, Opposer in the South Carolina action filed its Answer and Counterclaims and plead trademark infringement, unfair trade practices and included a prayer for relief that Applicant be ordered to expressly abandoned its trademark

¹ Opposer has also instigated a later filed action in the United States District Court, District of Massachusetts, containing the same issues as that of the first filed South Carolina action. Opposer has also attempted to have the South Carolina action dismissed or transferred to Massachusetts. On September 16, 2004, the District of South Carolina DENIED Opposer's motion so that the South Carolina action will be moving forward. It is anticipated that the Massachusetts action will be dismissed or transferred to South Carolina.



application serial nos. 76/299,860 and 76/299,861. Opposer asserts the same grounds for its position in the South Carolina action that it asserted in the opposition.

Whenever it comes to the attention of the Board that parties to a pending case are engaged in a civil action which may have a bearing on the case, proceedings before the Board may be suspended until termination of that civil action. T.T.A.B. § 510.02(a). That is primarily because, when a civil action in a Federal district court, as in this case, and the Federal action involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See, e.g., *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

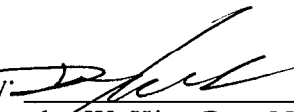
Further, for Opposer to prevail in the South Carolina action on its claims of trademark infringement and unfair trade practices, Opposer must prove the existence of its rights in the involved marks. Thus, if the district court finds that such rights exist, the court's findings will have a bearing on Applicant's claims and more importantly, those findings would be binding upon the Board. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986); *Other Telephone Co. v. National Telephone Co.*, 181 U.S.P.Q. 79 (Comm'r Pats. 1974); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805 (T.T.A.B. 1971).

Therefore, in the interest of judicial economy, and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the efforts of the Federal district court and the possibility of reaching an inconsistent conclusion, Applicant respectfully requests that the opposition proceeding be suspended indefinitely, pending final determination, including all appeals and remands, of the civil actions between the parties.

Respectfully submitted,

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Date: 9/21/04

By: 
Douglas W. Kim, Reg. No. 44,828
Attorneys for the Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail, postage prepaid, in an envelope addressed to U.S. Department of Commerce, Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513 on the date shown below.

Diane Freund

Date: September 21, 2004.

CERTIFICATE OF SERVICE

I hereby certify that I deposited a true copy of the foregoing *Applicant's Motion to Suspend Opposition Proceedings Pending the Outcome of Civil Litigation Case No: 8:04-CV-1397-27 Pending in the United States District Court, District of South Carolina* with the U.S. Postal Service as first class mail, postage prepaid, addressed to Opposer, Hill Design, Inc., namely, Garfield Goodrum, Hill Design, Inc., 631 Town Hill Road, Reading, VT 05062 on the date shown below.

Diane Freund

Date: September 21, 2004.

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HILL DESIGN, INC.,

Opposer,

v.

ROYLCO, INC.

Applicant.

Applicant: Roylco, Inc.

Marks: BROWN BAG CRAFTS
BROWN BAG CRAFTS and DESIGN

Opposition No: 91158755

Serial Nos: 76/299,860 and 76/299,861

Atty. Docket No: 029102.00006

U.S. Department of Commerce
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
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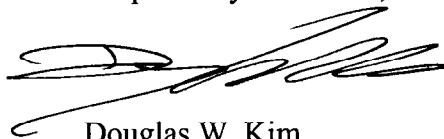
To the Trademark Trial and Appeal Board:

TRANSMITTAL LETTER

Please find the following correspondence items enclosed for filing in the United States Patent and Trademark Office:

1. *Applicant's Motion to Suspend Opposition Proceedings Pending the Outcome of Civil Litigation Case No: 8:04-CV-1397-27 Pending in the United States District Court, District of South Carolina*, with attached Certificate of Service (in triplicate); and
2. Return receipt postcard.

Respectfully submitted,



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